



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,289	10/30/2000	Takaaki Inoue	001448	4397

7590

04/30/2003

ARMSTRONG, WESTERMAN, HATTORI  
McLELAND & NAUGHTON  
1725 K. Street, N.W. Suite 1000  
Washington, DC 20006

EXAMINER

BEX, PATRICIA K

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/698,289

Applicant(s)

INOUE ET AL.

Examiner

P. Kathryn Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "9" has been used to designate both "analysis means" and "selection means", page 29, line 9. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Language*

2. Claim 2, line 2 recites the limitation "the operation contents ". There is insufficient antecedent basis for this limitation in the claim. Same deficiency was found in claim 3.
3. Claim 4, line 3-4 recites the limitation "the protocol" and "the protocol line". There is insufficient antecedent basis for this limitation in the claim. Same deficiency was found in claim 6.
4. Claim 5, line 4, "said storage means" lacks antecedent basis.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 1743

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 are rejected under 35 U.S.C. 102(a) as being anticipated by Inoue *et al* (JP 2000-93786).

Inoue *et al* teach a synthesis control system to specify vessels 22 in a reaction block 21. The system utilizing a protocol which is prepared by displaying the vessels 22 on the screen and selecting between the vessels 22 displayed on the screen to obtain the specified vessel 22. In addition, the automatic synthesis system 1 comprises a display device 4 for displaying at least, some of the vessels 22 in the reaction container 21 and a selection means 5 for selecting between the vessels 22 displayed on the display device 4 and a protocol creation means 7 for creating a protocol causing the display to display the vessel in a manner such that they can be identified on the display together. Further, the display device 4 is capable of identifying the details of the operation for the vessels 22 selected by the selection means 5.

7. Claims 6-7 are rejected under 35 U.S.C. 102(a) as being anticipated by Inoue *et al* (JP 2000-117098).

Inoue *et al* teach a synthesis control system to specify vessels 22 in a reaction block 21. The system utilizing a protocol which is prepared by displaying the vessels 22 on the screen and selecting between the vessels 22 displayed on the screen to obtain the specified vessel 22 in a protocol. In addition, the automatic synthesis system 1 comprises a display device 4 for displaying some of the vessels 22 in the reaction container 21 and a selection means 5 for selecting between the vessels 22 displayed on the display device 4 and a protocol creation means 7 for creating the protocol causing the monitor to display the vessel in such a manner that they can be identified on the display together. Further, Inoue *et al* teach an analyzing means 9

Art Unit: 1743

to analyze the synthesis protocol which regulates a series of commands to determine the procedure for the synthesis of compounds and to extract commands relating to the selected vessels 22 from the synthesis protocol.

8. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang *et al* (USP 6,489,168 B1).

Wang *et al* teach a analysis and control system comprising a monitor 150 for displaying vessels 210 housed in a reaction block 110 and a selection means 600,680 for selecting one or more vessels displayed on the screen based on data provided by the user 170/150 or storage means 180, such that the selector can modify the operation parameters (e.g. temperature, pH, etc) related to the selected vessels (column 12, lines 46-52, Figs. 6a-6b). Moreover, Wang *et al* teach a protocol creation means 700 for creating a protocol based on data supplied from the selector and displaying the vessels together with operation contents of the vessels (Figs. 7a-8, claim 3). Additionally, Wang *et al* teach an analysis means 145 or protocol line analysis means for picking out the operation contents supplied by the user/ storage and creating the operational procedure related to the selected vessel (Figs. 1, 3).

9. Claims 1-3, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Babson *et al* (USP 5,316,726).

Babson *et al* teach a analysis and control system comprising a monitor 16 for displaying vessels housed in an analyzer system and a selection means (e.g. bar code) for providing data which is displayed on the screen of the display device. Moreover, Wang *et al* teach a protocol creation means 700 for creating a protocol based on data supplied from the

Art Unit: 1743

selector means and displaying the vessels together with operation contents of the vessels (column 12, lines 45-67, Fig. 7).

**Conclusion**

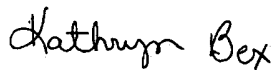
10. No claims allowed.


11. The prior art made of record and not relied upon which is considered pertinent to applicant's disclosure are Flavin *et al*, Arai *et al*, Bender *et al*, and Sugwara *et al*. They are cited of interest in that they show various embodiments of automated synthesis apparatus and control means.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
P. Kathryn Bex  
Patent Examiner  
AU 1743  
April 25, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700